



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/305,984 05/05/99 NOVAK

R 1340-1-016-N

EXAMINER

HM22/0212

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LEE, L
ART UNIT

PAPER NUMBER

1645
DATE MAILED:

02/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/305,984

Applicant(s)

Novak et al

Examiner
Li Lee

Group Art Unit
1645



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either ~~three~~ months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jan 5, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☒ ^{was} ~~will be entered upon filing of a Notice of Appeal and an Appeal Brief.~~ *See the attachment.*
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☐ Applicant's response has overcome the following rejection(s): _____

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attachment.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: None

Claims objected to: None

Claims rejected: 34-39, 68, and 69

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

Art Unit: 1645

Advisory Action

Applicant's response filed on 1/5/01 has been considered and entered. Applicant's response ~~concerning~~ "Novak et al (1999) do not state that all vancomycin tolerant *Streptococcus pneumoniae* have a defective His-Asp phosphorelay pathway" is acknowledged. However, Applicant's arguments and the Examiner's response are essentially the same as set forth in paper No. 12. Novak et al clearly indicate that vancomycin tolerance in mutant *Streptococcus pneumoniae* is due to the defective His-Asp phosphorelay pathway. One ^{skilled} ~~skill~~ in the art will conclude that the the vancomycin tolerant mutant *Streptococcus pneumoniae* of Williamson and Tomasz is a His-Asp phosphorelay pathway defective bacterial cell. There may be other reasons to cause a mutation in *Streptococcus pneumoniae*. However, Applicant fails to provide evidence that the vancomycin tolerant mutant *Streptococcus pneumoniae* of Williamson and Tomasz is not a His-Asp phosphorelay pathway defective bacterial cell. The burden is on applicants to show an unobvious distinction between the material structural and functional characteristics of the claimed product and the product of the prior art. Further, Williamson and Tomasz also teach a method of using the vancomycin tolerant cell that have a defective His-Asp phosphorelay pathway (Materials and Methods, e.g., Susceptibility tests, Selection of tolerant, autolytic mutants, and Assay for release of wall material). Thus, Williamson and Tomasz meet the limitations of the claims.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee
February 9, 2001

LFS
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